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EXAMINER	
JOHN, BAGVAN CLARENCE	
ART UNIT	PAPER NUMBER
4121	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/541,481	ARAUZ-ROSADO, JESUS-JAVIER	
	Examiner	Art Unit	
	B. CLARENCE JOHN	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 July 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/6/2005, 8/9/2006

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DETAILED ACTION

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 -14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 recites, An apparatus for controlling the codec selection … "means for receiving …, means for storing …, means for sending …, means for selecting …".

The terms "means" in the body of the claim are not limited to hardware structure. As is evident from Specification (page 5, paragraph [0071]), the functional elements can be implemented by means of "software".

Therefore claim 8 is non-statutory under 35 U.S.C. 101 because they are directed to software *per se*, none of a process, machine, manufacture or composition of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Riddle (US 6,175,856) in view of Garakani et al. (US 6,587,087).

With respect to Claim 1, Riddle teaches a method in a telecommunication system for controlling codec selection by a server, said telecommunication system including: a first physical network and a second physical network; and endpoint devices connected to said first and second physical networks, which networks offer each a bandwidth capacity, the method comprising the steps of:

(a) storing information related to at least one funnel network element that links said first and second physical networks, (Page 8, lines 42 – 52) said information including an address associated with said funnel network element; (Page 9, lines 2-6).

(b) receiving a communication request from a first one of the endpoint devices, (Page 7, lines 60-64); said request containing a set of advertised codecs for said communication; (Page 9, lines 2-16. Here, initiation of communication includes set of codecs).

(d) selecting at least one of said advertised codecs for being used for said communication, (Page 7, lines 35-36, Page 9, lines lines 23-28);

With respect to Claim 1 (c) and 1 (d), Riddle teaches all limitations of Claim 1. However, Riddle fails to teach sending an address detection message towards said first endpoint device and the selection being performed in dependence on if the answer to said address detection message includes a said address of said funnel network element.

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Conversely, Garakani does in fact teach limitations 1c (Page 1, lines 42-44 and Page 9, lines 23-26) and 1d (Page 9 - lines 23-26, Page 23 Table C – Column 2. Table C is obtained by ARP protocol through ARP request and ARP response. The response includes the MAC address).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Garakani and modify the teaching of Riddle in order to select the best codec based on the address of the endpoint device.

With respect to Claim 2, Riddle teaches the method of claim 1, wherein said stored information related to the funnel network element further includes information about the bandwidth supported for communications through said funnel network element, (Figure

5, step 510 and Page 8, lines 39-45) and wherein the selection of step (d) further depends on said bandwidth information. (Figure 5, step 512).

With respect to Claim 3, Riddle teaches the method of claim 1, wherein the stored information related to the funnel network element further comprises information about the codecs supported for communication through said funnel network element, (Figure 5, step 508, step 510); and wherein the selection of step (d) further depends on said codec information. (Figure 5, step 512).

With respect to Claim 4, Riddle teaches all limitations of Claim 1.

However, Riddle fails to teach the method of claim 1, wherein said address detection message is a path-discovery message.

Conversely, Garkani does in fact teach such a limitation. (Page 1, lines 42-45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Garakani and modify the teachings of Riddle in order to determine the network address of the end device so that the best codec can be selected.

With respect to Claim 5, Riddle teaches all limitations of Claim 4.

However, Riddle fails to teach the method of claim 4, wherein said address detection message is a path-discovery message is a TRACEROUTE message.

Conversely, Garkani does in fact teach such a limitation. (Page 1, lines 42-45).
See the above discussion in Claim 4.

With respect to Claim 6, Riddle teaches all limitations of Claim 1.

However, Riddle fails to teach the method of claim 1, wherein said address detection message is an address-resolution message.
Conversely, Garkani does in fact teach such a limitation. (Page 9, lines 23-26).
See the above discussion in Claim 4.

With respect to Claim 7, Riddle teaches all limitations of Claim 6.
However, Riddle fails to teach the method of claim 6, wherein said address detection message is an ARP message.
Conversely, Garkani does in fact teach such a limitation. (Page 9, lines 23-26).
See the above discussion in Claim 4.

With respect to Claim 8, Riddle teaches an apparatus for controlling the codec selection in a server of a telecommunication system, said telecommunication system including at

least a first physical network and a second physical network and a plurality of endpoint devices connected to said first and second physical networks, each of said physical networks offering each a bandwidth capacity, the apparatus including comprising:

(a) means for receiving a communication request from a first one of the endpoint devices, (Page 7, lines 60-64); said request containing a set of advertised codecs for said communication; (Page 9, lines 2-16. Here, initiation of communication includes set of codecs).

(b) means for storing information related to at least one funnel network element that links said first and second physical networks, (Page 8, lines 42 – 52) said information including at least one address associated with said funnel network element; (Page 9, lines 2-6).

(d) means for selecting at least one of said advertised codecs to be used for said communication, (Page 7, lines 35-36, Page 9, lines lines 23-28);

With respect to Claim 8 (c) and (d), Riddle teaches all limitations of Claim 8. However, Riddle fails to teach means for sending an address detection message towards said endpoint; and the selection being performed in dependence on if the

answer to said address detection message includes a said address of said funnel network element.

Conversely, Garakani does in fact teach limitations 8c (Page 1, lines 42-44 and Page 9, lines 23-26) and 8d (Page 9 - lines 23-26, Page 23 Table C – Column 2. Table C is obtained by ARP protocol through ARP request and ARP response. The response includes the MAC address).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Garakani and Riddle by modifying the teaching of Riddle in order to select the best codec based on the address of the endpoint device.

With respect to Claim 9, Riddle teaches the apparatus of claim 8, wherein said stored information related to the funnel network element further includes information about the bandwidth supported for communication through said funnel network element, (Figure 5, step 510 and Page 8, lines 39-45)

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and wherein said means for selecting (d) are further arranged for selecting at least one of the codecs in dependence on said bandwidth information. (Figure 5, step 512).

With respect to Claim 10, Riddle teaches the apparatus of claim 8, wherein the stored information related to the funnel network element further includes information about the

codecs supported for a communication through said funnel network element, (Figure 5, step 508, step 510);

and wherein said means for selecting (d) are further arranged for selecting at least one of the codecs in dependence on said codec information. (Figure 5, step 512).

11. With respect to Claim 11, Riddle teaches all limitations of Claim 8.

However, Riddle fails to teach the apparatus of claim 8, wherein said address detection message is a path-discovery message.

Conversely, Garkani does in fact teach such a limitation. (Page 1, lines 42-45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Garakani and Riddle by modifying the teaching of Riddle in order to determine the network address of the end device so that the best codec can be selected.

With respect to Claim 12, Riddle teaches all limitations of Claim 11.

However, Riddle fails to teach the apparatus of claim 11, wherein said address detection message is a path-discovery message is a TRACEROUTE message.

Conversely, Garkani does in fact teach such a limitation. (Page 1, lines 42-45).

See the above discussion in Claim 11.

With respect to Claim 13, Riddle teaches all limitations of Claim 8.

However, Riddle fails to teach the apparatus of claim 8, wherein said address detection message is an address-resolution message.

Conversely, Garkani does in fact teach such a limitation. (Page 9, lines 23-26).

See the above discussion in Claim 11.

With respect to Claim 14, Riddle teaches all limitations of Claim 13.

However, Riddle fails to teach the apparatus of claim 13, wherein said address detection message is an ARP message.

Conversely, Garkani does in fact teach such a limitation. (Page 9, lines 23-26).

See the above discussion in Claim 11.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. CLARENCE JOHN whose telephone number is (571)270-5937. The examiner can normally be reached on Weekdays from 7:30 AM - 5:00 PM, Monday - Thursday and Alternate Fridays, from 7:30AM-4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Robertson can be reached on (571)272-4186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BCJ/
B. Clarence John
Patent Examiner
10/1/2008

/Philip C Lee/
Examiner, Art Unit 2452